

REMARKS

By this amendment, Applicant amends claims 1, 5, 11, and 12, and cancels claims 32 and 33 without prejudice or disclaimer. Claims 1-19 and 21-31 are now pending in this application.

In the Final Office Action¹, the Examiner took the following actions:

withdrew claims 32 and 33 as allegedly being drawn to a non-elected invention;

rejected claims 1, 2, 5, 11, 12, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Foladare et al. (U.S. Patent No. 5,831,860) in view of Franco (U.S. Patent No. 7,257,552);

rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Roberts et al. (U.S. Patent No. 6,401,078);

rejected claims 6-10, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, Roberts, and Lopez (U.S. Application Publication No. 2002/0029202);

rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, and Lopez;

rejected claims 14, 15, 19, 28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Barta et al. (U.S. Patent No. 6,634,5551);

rejected claims 16-18 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco, Barta, and Lopez;

rejected claims 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, Barta and Kadaba (U.S. Patent No. 6,539,360); and

¹ The Final Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

rejected claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, Barta, and Jones (U.S. Patent Application Publication No. 2003/0233190).

I. Withdrawal of Claims 32 and 33

Applicant respectfully traverses the withdrawal of claims 32 and 33 as allegedly being drawn to a non-elected invention. However, to expedite prosecution, Applicant has cancelled claims 32 and 33.

II. Rejection of Claims 1, 2, 5, 11, 12, and 31 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1, 2, 5, 11, 12, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites a method for changing the delivery point of an item while the item is en route including, among other steps, “notifying a recipient, based on the first delivery point, that the item is en route” and “notifying a sender, based on an identifier of the sender obtained from the item, that the item is en route.”

The Final Office Action admits that Foladare “fails to disclose notifying, based on an identifier of a sender, the sender that the item is en route” (emphasis omitted). Final Office Action at page 3. However, the Final Office Action alleges that Franco “teaches notifying a sender through shipping documents including bar-coded address labels.” Id. However, even if this is correct, which Applicant does not concede, Franco does not teach or suggest at least “notifying a **sender**, based on an **identifier of the sender obtained from the item**, that the item is en route,” as recited in independent claim 1 (emphasis added).

In the portion cited in the Final Office Action, Franco discloses:

At step 2907 shipping documents including bar-coded address labels are generated preferably by the VIMS 200. Bar-coded address labels are desirable for improving the efficiency of the shipping process. At step 2908, the shipping documentation is processed. This step preferably involves sending confirmations of the shipment to the sender, carrier, and receiver, generating shipping schedules, generating applicable billing information, notifying the receiver upon arrival of the parcel at the identified OAS 400, notifying the sender upon receipt of the parcel by the receiver, etc.

Franco, col. 62, line 55 to col. 63, line 7.

As set forth above, in Franco, shipping documents including bar-coded address labels are generated by a Virtual Inventory Management System (i.e., VIMS 200). In the Franco system, the shipping documentation is then processed. However, Franco does not disclose or suggest that the sender of an item is notified that the item is en

route, based on an identifier of the sender that is obtained from the item. In contrast, regarding identifying a sender, Franco merely discloses “[a]ssuming the sender is a registered user of the [Product Distribution Management System] 00, upon logging on, the sender can be automatically recognized and identified.” Col. 62, lines 19-21.

However, Franco does not disclose or suggest “notifying a **sender**, based on an **identifier of the sender obtained from the item**, that the item is en route,” as recited in independent claim 1 (emphasis added).

Independent claim 11, although of a different scope, include recitations similar to those discussed above in connection with independent claim 1. Accordingly, Foladare and Franco do not teach or suggest all of the elements of independent claim 11 for at least reasons similar to those discussed above.

Independent claim 5 recites a method including, among other steps, “confirming the instruction to deliver the item to the second delivery point by notifying a sender of the second delivery point, based on an identifier of the sender obtained from the item.” The Final Office Action admits that Foladare does not “explicitly disclose confirming the instruction to deliver the item to the second delivery point by notifying a sender of the second delivery point.” However, the Final Office Action alleges that Franco compensates for this deficiency of Foladare, citing reasons similar to those that were advanced against independent claim 1. The allegations are incorrect for at least two reasons.

First, Franco does not disclose or suggest “**confirming the instruction** to deliver the item to the second delivery point by notifying a sender of the second delivery point, based on an identifier of the sender obtained from the item,” as recited in independent

claim 5 (emphasis added). Although the Final Office Action alleges that Franco discloses returning an item and printing a return authorization (see Final Office Action at page 6), returning an item and printing a return authorization do not constitute or suggest **confirming an instruction** to deliver the item to a second delivery point. Furthermore, any such return of an item in Franco is made by the recipient, not the sender. Therefore, Franco does not disclose or suggest “**confirming the instruction** to deliver the item to the second delivery point **by notifying a sender** of the second delivery point,” as recited in independent claim 5 (emphasis added).

Second, as discussed above, Franco does not disclose or suggest that the sender is notified, based on an identifier of the sender that is obtained from an item. Instead, Franco merely discloses that, “[a]ssuming the sender is a registered user of the [Product Distribution Management System] 00, upon logging on, the sender can be automatically recognized and identified.” Col. 62, lines 19-21. Accordingly, Franco does not disclose or suggest “confirming the instruction to deliver the item to the second delivery point by **notifying a sender** of the second delivery point, **based on an identifier of the sender obtained from the item**,” as recited in independent claim 5 (emphasis added).

Independent claim 12 recites a “system for changing the delivery point of an item including a unique identifier of a sender of the item while the item is en route” including, among other things, “means for notifying a sender that the item is en route based on the unique identifier.” Although Franco discloses “notifying the receiver upon arrival of the parcel at the identified [Order Aggregation Site] OAS 400, [and] notifying the sender upon receipt of the parcel by the receiver” (col. 63, lines 1-7)(emphases added), Franco

does not disclose or suggest at least “means for notifying a sender that the item is en route **based on the unique identifier [from the item],**” as recited in amended independent claim 12 (emphases added).

As explained above, the elements of independent claims 1, 5, 11 and 12 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combinations. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 1, 5, 11 and 12 under 35 U.S.C. § 103(a).

Claims 2 and 31 depend from independent claims 1 and 12, respectively. Accordingly, claims 2 and 31 are not obvious in view of the cited references at least due to their dependence. Therefore, the Examiner also should withdraw the rejection of claims 2 and 31 under 35 U.S.C. § 103(a).

III. Rejection of Claim 3 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Roberts.

Claim 3 depends from claim 1. As discussed above, Foladare and Franco do not teach or suggest “notifying, based on an identifier of a sender obtained from the item,

the sender that the item is en route,” as recited in independent claim 1. Moreover, Roberts does not compensate for the deficiencies of Foladare and Franco.

Roberts discloses “receiving transportation documentation and producing advance loading manifests . . . to optimize load planning and dynamic product shipment and delivery control.” Abstract. However, Roberts does not teach or suggest “notifying, based on an identifier of a sender obtained from the item, the sender that the item is en route,” as recited in independent claim 1 and required by claim 3 due to its dependence.

As explained above, the elements of the claims are neither taught nor suggested by the cited references. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 3 under 35 U.S.C. § 103(a).

IV. Rejection of Claims 6-10 and 13 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 6-10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, Roberts, and Lopez.

Independent claim 6 recites a method for handling an undeliverable item including, among other steps, “accepting a disposition instruction from the sender, after . . . notifying [the sender that the item is undeliverable]” and “changing a delivery point of the item while the item is en route after accepting the disposition instruction.”

The Final Office Action admits that Foladare “fails to disclose notifying the sender that the item is undeliverable; accepting a disposition instruction from the sender, after the notifying; [and] changing a delivery point of the item while the item is en route after accepting the disposition instruction.” Final Office Action at page 8.

The Final Office Action again alleges that Franco “teaches notifying a sender through shipping documents including bar-coded address labels.” Final Office Action at page 8. However, this does not constitute or suggest “accepting a disposition instruction from the sender, after . . . notifying [the sender that the item is undeliverable]” and “changing a delivery point of the item while the item is en route after accepting the disposition instruction,” as claimed.

The Final Office Action also refers to Lopez, but Lopez also does not compensate for the deficiencies of Foladare and Franco. Lopez discloses:

Some of the mailpieces to be processed are to be forwarded to a receiver forwarding address and some are to be returned to the sender. Some sender's will desire to be notified of the forwarding address when a mailpiece has been forwarded. If a mailpiece is returned, a sender is to be informed as to the reason why. Additionally, for some mailpieces that cannot be delivered but are not worth the cost of return postage, the senders nonetheless will want notification of the non-delivery.

Paragraph [0035].

Although Lopez discloses forwarding mailpieces to a receiver forwarding address and returning mailpieces to a sender, Lopez does not teach accepting a disposition instruction after notifying the sender that the item is undeliverable. Moreover, Lopez does not teach changing a delivery point of an item while it is en route after accepting the disposition instruction. That is, Lopez does not teach or suggest “accepting a **disposition instruction** from the sender, **after . . . notifying [the sender that the item**

is undeliverable]” and “changing a delivery point of the item while the item is en route **after accepting the disposition instruction,**” as recited in independent claim 6 (emphases added).

The Final Office Action also refers to Roberts and alleges that the reference “teaches redirection of the vehicle and/or portions of the load en route may be desirable to respond to customers (shippers) needs or other factors.” Final Office Action at page 8. However, this also does not constitute or suggest “accepting a **disposition instruction** from the sender, **after . . . notifying [the sender that the item is undeliverable]**” and “changing a delivery point of the item while the item is en route **after accepting the disposition instruction,**” as recited in independent claim 6 (emphases added).

As explained above, the elements of independent claim 6 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 6 under 35 U.S.C. § 103(a).

Claims 7-10 depend from independent claim 6 and are not obvious in view of the cited references at least due to their dependence. Independent claim 13, although of a

different scope, includes recitations similar to claim 6. Accordingly, independent claim 13 is not obvious in view of the cited references for at least the reasons discussed above. Therefore, the Examiner should withdraw the rejection of claims 7-10 and 13 under 35 U.S.C. § 103(a).

V. Rejection of Claim 4 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, and Lopez.

Claim 4 depends from claim 1. As discussed above, Foladare and Franco do not teach or suggest “notifying, based on an identifier of a sender obtained from the item, the sender that the item is en route,” as recited in independent claim 1. Moreover, Lopez does not compensate for the deficiencies of Foladare and Franco.

As explained above, the elements recited in claim 1 and required by claim 4 are neither taught nor suggested by the cited references. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 4. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 4 under 35 U.S.C. § 103(a).

VI. Rejection of Claims 14, 15, 19, 28, and 30 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 14, 15, 19, 28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco and Barta.

Independent claim 14 recites a method to flexibly deliver an item including, among other things, “conditionally accepting a second delivery point of the item, comprising requesting, from the sender, an approval of the second delivery point.”

The Final Office Action admits that Foladare “fails to explicitly disclose conditionally accepting a second delivery point” (emphases omitted). Final Office Action at page 11. The Final Office Action then refers to Franco and Barta, but these references do not compensate for the deficiencies of Foladare.

The Final Office Action again alleges that Franco “teaches notifying a sender through shipping documents including bar-coded address labels” and returning an item with a return authorization.” Final Office Action at page 11. However, this does not constitute or suggest “conditionally accepting a second delivery point of the item, comprising requesting, from the sender, an approval of the second delivery point,” as claimed.

Barta also does not compensate for the deficiencies of the other references. Barta discloses that a “customer can . . . be told by . . . [a] delivery service that the customer has . . . packages which were previously undelivered” and “the customer could initiate a ‘delivery change’ request, in which the customer could key in a new address.” Col. 7, lines 21-35. Thus, in Barta, the recipient (i.e., the customer) can request a delivery change to have a package delivered to a new address. However,

this does not constitute or suggest requesting an approval of a second delivery point from a sender. That is, Barta does not teach or suggest “conditionally accepting a second delivery point of the item, comprising **requesting, from the sender, an approval of the second delivery point,**” as recited in independent claim 14 (emphasis added).

As explained above, the elements of independent claim 14 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 14 under 35 U.S.C. § 103(a).

Claims 15, 19, and 28 depend from independent claim 14 and are not obvious in view of the cited references at least due to their dependence. Independent claim 30, although of a different scope, includes recitations similar to claim 14. Accordingly, independent claim 30 is not obvious in view of the cited references for at least the reasons discussed above. Therefore, the Examiner should withdraw the rejection of claims 15, 19, 28, and 30 under 35 U.S.C. § 103(a).

VII. Remaining Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 16-18 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Franco, Barta, and Lopez; the rejection of claims 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, Barta and Kadaba; and the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Foladare, Franco, Barta, and Jones.

Claims 16-18, 21-27, and 29 depend from independent claim 14. As discussed above, Foladare, Franco, and Barta do not teach or suggest “conditionally accepting a second delivery point of the item, comprising requesting, from the sender, an approval of the second delivery point,” as recited in independent claim 14. Furthermore, Lopez, Kadaba, and Jones do not compensate for the deficiencies of Foladare, Franco, and Barta.

As explained above, the elements of the claims are neither taught nor suggested by the cited references. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combinations. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 16-18, 21-27, and 29 under 35 U.S.C. § 103(a).

CONCLUSION

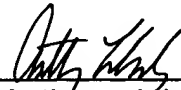
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 21, 2009

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